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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants	:	Neubauer, et al.)	I hereby certify that this paper is being sent
Ser. No.	:	10/646,514)	by facsimile transmission to the central
Filed	:	August 22, 2003)	facsimile number of the U.S. Patent and
Title	:	Information Item Forming)	Trademark Office, via facsimile number 571-
		Machine and Method)	273-8300, on the date sent forth below:
Art Unit	:	3721)	Date: November 8, 2005
Examiner	:	Paul Durand)	<i>Martin J. Hirsch</i> Martin J. Hirsch Registration No. 32,237

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal brief is submitted pursuant to the Notice of Appeal filed August 9, 2005, in connection with the present application.

(1) REAL PARTY IN INTEREST

The real party in interest is Vijuk Equipment, Inc., the assignee of rights in the present application via an assignment recorded in the Patent Office at Reel 011820, Frame 0124 in connection with the parent application, U.S. Serial No. 09/723,598.

(2) RELATED APPEALS AND INTERFERENCES

The rejections of the claims of two other patent applications, U.S. Serial Nos. 10/940,138 and 10/940,367, were also appealed to the Patent Office Board of Appeals. Both of those applications are continuations of the present application. Those applications are not considered to be substantively related since different issues are believed to be presented.

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(3) STATUS OF CLAIMS

All claims in the application, claims 48-57 stand rejected, and the rejection of claims 48-57 is being appealed. The appealed claims are reproduced in the Claims Appendix included herewith.

(4) STATUS OF AMENDMENTS

No amendment of the claims was made subsequent to the final rejection.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to the formation of outserts, which are bidirectionally folded leaflets which are widely used in connection with the sale of pharmaceutical products, such as prescription drugs. Such an outsert, which is typically attached to a drug container, such as a bottle of pills, or disposed within a cardboard box in which a drug is marketed, has detailed information, such as risk factors, regarding the drug printed thereon. See, for example, Paragraph [0003] of the present application.

The subject matter defined in claim 48 is directed to a method of forming outserts having product information printed thereon. Referring to Figs. 3A-3F, Figs. 5A-5D, Figs. 10A-10B and Paragraph [0090] on page 17 of the present application, the method of claim 48 includes (a) folding a sheet of paper 70 having product information printed thereon by making a plurality of folds in the sheet of paper to form a first folded article, the folds in the sheet of paper being parallel to each other and parallel to a first direction, the folds in the sheet of paper being made using a first folding apparatus 210 having a plurality of folding rollers 310-321.

Referring to Figs. 3G-3H, Figs. 5A-5D, Figs. 11A-11D and Paragraph [0094] on page 18 of the present application, the method of claim 48 includes (b) folding the first folded article by making a fold in the first folded article to form a second folded article, the fold in the first folded article being parallel to a second direction, the second direction being perpendicular to the first direction, the fold in the first folded article being made using a second folding apparatus 212 having a plurality of folding rollers 350-353 and (c) folding the second folded article by making a fold in the second folded article to form a third folded article, the fold in the second folded article being parallel to the second direction.

Referring to Figs. 5A-5D, Fig. 12 and Paragraphs [0098]-[0100] on page 19 of the present application, the method of claim 48 includes (d) applying pressure to a folded

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article formed as a result of at least paragraphs (a), (b) and (c), the pressure being at least about 30 psi and being no greater than about 500 psi, the pressure being applied by a pressing unit 214 having a pair of pressure rollers 409.

Referring to Fig. 3J, Figs. 5A-5D, Figs. 13A-13B, Fig. 18A, Paragraph [0101] on page 20 and Paragraphs [0180], [0186] and [0188] of the present application, the method of claim 48 also includes (e) depositing an adhesive on a portion of a folded article formed as a result of at least paragraphs (a), (b) and (c) and (f) making a final fold in a folded article formed as a result of at least paragraphs (a), (b) and (c) to form an outsert, the final fold being parallel to the second direction and being made so that the adhesive holds the outsert in a substantially closed position so that the outsert has no exposed unfolded exterior edges that lie in a direction parallel to the final fold, the final fold being made using a final folding apparatus 216 comprising a plurality of folding rollers 418, 420 having a nip therebetween and a movable blade member 416 that forces a portion of a folded article formed as a result of at least paragraphs (a), (b) and (c) towards the nip between the folding rollers 418, 420 of the final folding apparatus 216.

Referring to Figs. 5A-5D, Figs. 10A-10B and Paragraph [0090] on page 17 of the present application, the subject matter defined in independent claim 53 is directed to an outsert-forming apparatus that comprises a first folding unit 210 that forms a first folded article from a sheet of paper having printed information thereon, the first folding unit 210 having a plurality of folding rollers 310-321 and forming the first folded article by making a plurality of folds in the sheet of paper, each of the folds being parallel to a first direction and a second folding unit 212 operatively coupled to receive the first folded article, the second folding unit 212 forming a second folded article from the first folded article by making at least one fold in the first folded article in a direction parallel to a second direction, the second direction being perpendicular to the first direction.

Referring to Figs. 5A-5D, Fig. 12 and Paragraphs [0098]-[0100] on page 19 of the present application, the apparatus of claim 53 also comprises a pressing unit 214 operatively coupled to receive a folded article having folds formed by at least the first and second folding units 210, 212, the pressing unit 214 comprising a plurality of pressure rollers 409 and applying a pressure of at least about 30 psi and no greater than about 500 psi.

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Referring to Fig. 3J, Figs. 5A-5D, Figs. 13A-13B, Fig. 18A, Paragraph [0101] on page 20 and Paragraphs [0180], [0186] and [0188] of the present application, the apparatus of claim 53 also comprises an adhesive applicator 802 that applies adhesive to a portion of a folded article having folds formed by at least the first and second folding units 210, 212 and a final folding unit 216 operatively coupled to receive a folded article having folds formed by at least the first and second folding units 210, 212, the final folding unit 216 forming an outsert by making a final fold in a folded article having folds formed by at least the first and second folding units 210, 212, the final fold being made parallel to the second direction, the final fold being made so that the adhesive holds the outsert in a substantially closed position so that the outsert has no exposed unfolded exterior edges that lie in a direction parallel to the final fold.

Referring to Figs. 13A-13B of the present application, the final folding unit 216 of the apparatus of claim 53 comprises a first folding roller 418, a second folding roller 420 disposed adjacent the first folding roller 418 of the final folding unit 216, the first and second folding rollers 418, 420 of the final folding unit 216 having a nip therebetween, the first and second folding rollers 418, 420 of the final folding unit 216 causing the final fold to be made when a folded article having folds formed by at least the first and second folding units 210, 212 passes between the first and second folding rollers 418, 420 of the final folding unit 216; and a movable blade member 416 that forces a portion of a folded article having folds formed by at least the first and second folding units 210, 212 towards the nip between the first and second folding rollers 418, 420 of the final folding unit 216.

None of the claims includes any "means for" or "step for" language as defined in 35 U.S.C. §112, paragraph 6.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether or not a prima facie case of unpatentability has been made of claims 48-52 under 35 U.S.C. §103(a) over U.S. Patent No. 6,068,300 to Vijuk, et al. in view of U.S. Patent No. 4,606,784 to Glans, et al. and further in view of U.S. Patent No. 4,812,195 to Vijuk.

B. Whether or not a prima facie case of unpatentability has been made of claim 53 under 35 U.S.C. §103(a) over U.S. Patent No. 6,068,300 to Vijuk, et al. in view of U.S. Patent No. 4,606,784 to Glans, et al. and further in view of U.S. Patent No. 4,812,195 to Vijuk and U.S. Patent No. 6,475,129 to Lehmann.

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C. Whether or not a prima facie case of unpatentability has been made of claims 54-57 under 35 U.S.C. §103(a) over U.S. Patent No. 6,068,300 to Vijuk, et al. in view of U.S. Patent No. 4,606,784 to Glans, et al., U.S. Patent No. 4,812,195 to Vijuk, U.S. Patent No. 6,475,129 to Lehmann and further in view of U.S. Patent No. 4,527,319 to Rosenbaum, et al.

(7) ARGUMENT

A. Claims 48-52

Independent claim 48 is directed to a method of forming outserts having product information printed thereon and includes the following paragraph:

(d) applying pressure to a folded article formed as a result of at least paragraphs (a), (b) and (c), said pressure being at least about 30 psi and being no greater than about 500 psi, said pressure being applied by a pressing unit having a pair of pressure rollers;

Claim 48 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,068,300 to Vijuk, et al. in view of U.S. Patent No. 4,606,784 to Glans, et al. and further in view of U.S. Patent No. 4,812,195 to Vijuk. In support of the rejection, the final Office Action states (on pages 2-3) the following:

What Vijuk '300 does not disclose is the use of a pressure roller or the folding device makeup. However, Glans teaches that it is old and well known in the art of folding to provide pressure rollers 11 mounted to housing 10, for the purpose of maintaining the article in a flat condition prior to a folding operation (see Fig. 1 and C2, L14-27).

* * *

Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Vijuk '300 with the pressure roller of Glans and the folding specifics of Vijuk '195 for the purpose of manufacturing a folded outsert.

It is respectfully submitted that there must be a suggestion in the prior art before prior art references can properly be combined in order to establish a prima facie case of obviousness. The mere fact that references can be combined is not sufficient to establish a prima facie case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original).

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The Office Action, citing to column 2, lines 14-27 of Glans, et al., states: "Glans teaches that it is old and well known in the art of folding to provide pressure rollers 11 mounted to housing 10, for the purpose of maintaining the article in a flat condition prior to a folding operation (underlining added). However, that is not the purpose of the Glans, et al. pressure rollers; they are used for an entirely different purpose.

The Glans, et al. patent is directed to the formation of a product package, such as a milk carton, having a paper substrate which is covered on both sides by a thermoplastic material in order to make the package liquid-tight. The Glans, et al. patent addresses particular problems, none of which is even an issue in the folding apparatus disclosed in either the Vijuk '195 patent or the Vijuk '300 patent. These particular problems are described in the Glans, et al patent as follows:

Packing containers of the non-returnable type for the packaging of e.g. milk and other liquid dairy products are manufactured from laminated packing material which includes a carrier layer of relatively stiff material, e.g. paper, which, at least on the side which is intended to be in contact with the contents, is covered with a liquid-tight, preferably thermoplastic material, e.g. polyethylene. Beside serving as a material conferring imperviousness, the thermoplastic layer is also used for making possible the heat-sealing of the laminate. For this reason, it is often advantageous if the opposite side, that is to say the outer side, of the carrier layer is also covered with a thermoplastic material. When the packing laminate is to be converted into packing containers these are formed in a known manner by folding and sealing of the laminate, so that packing containers of the desired shape are obtained. It is of the greatest importance that the seals, which unavoidably must be present on the finished packing container, should be completely impervious to liquid. This is particularly difficult to achieve if seals of the 'inside-to-outside' type are used, since the lower packing laminate edge, that is to say the edge facing towards the inside of the packing container, will then come into contact with the contents, not only with the thermoplastic-covered surface, but also with the cut edge itself where the carrier layer is exposed. In the case of a carrier layer of the fibrous type, this will gradually absorb contents, which detrimentally affects the tightness and the durability of the package. To prevent this it is known to double up the internal edge zone of the material so that the inner thermoplastic layer extends around the inner edge of the packing laminate and is sealed against the inside of the outer packing laminate. In this way contact between the contents and the carrier layer is effectively prevented so that the problem of absorption of the contents into the packing material is eliminated. (column 1, lines 14-50)

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It is respectfully submitted that, to overcome the above problems, the Glans, et al. patent discloses that the pressure rollers 11 are used to produce an effective liquid-tight seal, as indicated by the following excerpt of the Glans, et al. patent:

After the material web has left the last pair of rollers which is supported by the carrier elements 1, 2, it reaches the two cylindrical pressure rollers 11. With the help of these now the final doubling up and pressing together of the main part 17 and the edge zone 18 of the material web is achieved in such a way that the edge zone 18, with the help of the heated thermoplastic layer serving as an adhesive, is joined to the area of the main part 17 of the material web located underneath it. The distance between the two pressure rollers 11 is adjusted so that the web parts are pressed to each other with sufficient force to ensure that a reliable and durable seal is formed. The material web thus has been provided with the desired, doubled up and liquid-tight edge and is advanced further to be converted subsequently in a known manner to a liquid-tight material tube, which after filling with the desired contents, is converted to filled packing containers by repeated, transverse sealing operations. (column 8, lines 22-40)

The Vijuk '195 patent relates to the production of outserts, which are used to provide information regarding a pharmaceutical product. For example, column 3, lines 35-42:

As shown on the drawings for purposes of illustration, the invention is embodied in a method and apparatus 10 for folding elongated sheets 11 (FIG. 1) which are usually of paper having printed instructions or warnings about possible side effects of a pharmaceutical and the folded sheet has a last, or wrap-around fold 14 which is adhered by a glue or adhesive spot 15 to an adjacent inner fold 16 to complete an outsert 12.

The Vijuk '300 patent also relates to the production of outserts which provide information regarding pharmaceutical products. See, for example, column 1, lines 20-28 and Figs. 5 and 8 of the Vijuk '300 patent.

Since the purpose of the pressure rollers 11 of Glans, et al. is to make an effective liquid-tight seal, and since the outserts disclosed in the Vijuk '195 and '300 patents are not designed as containers or to hold any liquid product and therefore do not have any seal, it is respectfully submitted that there is no suggestion to incorporate the pressure rollers 11 of Glans, et al. into the folding apparatus of Vijuk '195 patent, and that one with ordinary skill in the art would not have been so motivated.

In view of the foregoing, it is respectfully submitted that the rejection of independent claim 48 is not proper for the reasons noted above. Since the rejection of dependent claims

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49-52 is based on the rejection of independent claim 48, it is respectfully submitted that the rejection of claims 49-52 is not proper for at least the reasons set forth above in connection with claim 48.

B. Independent Claim 53

Independent claim 53 is directed to an outsert-forming apparatus that forms outserts having printed product information thereon and includes the following paragraph:

a pressing unit operatively coupled to receive a folded article having folds formed by at least said first and second folding units, said pressing unit comprising a plurality of pressure rollers and applying a pressure of at least about 30 psi and no greater than about 500 psi;

With regard to the pressing unit recited in claim 53, the rejection of claim 53 relies upon the same reasoning as described above in connection with claim 48, and the Lehmann patent additionally applied in connection with the rejection of claim 53 is not used for any disclosure or suggestion of a pressing unit as recited in claim 53.

Consequently, it is respectfully submitted that the rejection of claim 53 is not proper for the reasons noted above in connection with independent claim 48.

C. Claims 54-57

Claims 54-57 depend from independent claim 53. Since the rejection of dependent claims 54-57 is based on the rejection of independent claim 53, it is respectfully submitted that the rejection of claims 54-57 is not proper for at least the reasons set forth above in connection with claim 53.

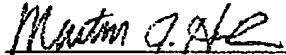
(8) CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejection of claims 48-57 is improper, and Appellants therefore request that the rejection of the claims be reversed.

Respectfully submitted,
MARSHALL, GERSTEIN & BORUN LLP

Date: November 8, 2005

By:

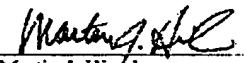


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Applicants	:	Neubauer, et al.)	I hereby certify that this paper is being sent by facsimile transmission to the central facsimile number of the U.S. Patent and Trademark Office, via facsimile number 571-273-8300, on the date sent forth below:
Ser. No.	:	10/646,514)	
Filed	:	August 22, 2003)	Date: November 8, 2005
Title	:	Information Item Forming Machine and Method)	 _____ Martin J. Hirsch
Art Unit	:	3721)	Registration No. 32,237
Examiner	:	Paul Durand)	

CLAIMS APPENDIX

The claims on appeal are reproduced below.

48. (Previously presented) A method of forming outserts having product information printed thereon, said method comprising:

(a) folding a sheet of paper having product information printed thereon by making a plurality of folds in said sheet of paper to form a first folded article, said folds in said sheet of paper being parallel to each other and parallel to a first direction, said folds in said sheet of paper being made using a first folding apparatus having a plurality of folding rollers;

(b) folding said first folded article by making a fold in said first folded article to form a second folded article, said fold in said first folded article being parallel to a second direction, said second direction being perpendicular to said first direction, said fold in said first folded article being made using a second folding apparatus having a plurality of folding rollers;

(c) folding said second folded article by making a fold in said second folded article to form a third folded article, said fold in said second folded article being parallel to said second direction;

(d) applying pressure to a folded article formed as a result of at least paragraphs (a), (b) and (c), said pressure being at least about 30 psi and being no greater than about 500 psi, said pressure being applied by a pressing unit having a pair of pressure rollers;

(e) depositing an adhesive on a portion of a folded article formed as a result of at least paragraphs (a), (b) and (c); and

(f) after (e), making a final fold in a folded article formed as a result of at least paragraphs (a), (b) and (c) to form an outsert, said final fold being parallel to said second direction and being made so that said adhesive holds said outsert in a substantially closed position so that said outsert has no exposed unfolded exterior edges that lie in a direction parallel to said final fold, said final fold being made using a final folding apparatus comprising a plurality of folding rollers having a nip therebetween and a movable blade member that forces a portion of a folded article formed as a result of at least paragraphs (a), (b) and (c) towards said nip between said folding rollers of said final folding apparatus.

49. (Previously presented) A method as defined in claim 48 comprising making a plurality of folds in said first folded article in said second direction to form said second folded article.

50. (Previously presented) A method as defined in claim 48 additionally comprising making at least one additional fold in said first folded article to form said second folded article.

51. (Previously presented) A method as defined in claim 48 additionally comprising automatically conveying said first folded article from said first folding apparatus to said second folding apparatus.

52. (Previously presented) A method as defined in claim 48 additionally comprising automatically conveying said second folded article from said second folding apparatus to said pressing unit.

53. (Previously presented) An outsert-forming apparatus that forms outserts having printed product information thereon, said apparatus comprising:

a first folding unit that forms a first folded article from a sheet of paper having printed information thereon, said first folding unit having a plurality of folding rollers and forming said first folded article by making a plurality of folds in said sheet of paper, each of said folds being parallel to a first direction;

a second folding unit operatively coupled to receive said first folded article, said second folding unit forming a second folded article from said first folded article by making at least one fold in said first folded article in a direction parallel to a second direction, said second direction being perpendicular to said first direction;

a pressing unit operatively coupled to receive a folded article having folds formed by at least said first and second folding units, said pressing unit comprising a plurality of pressure rollers and applying a pressure of at least about 30 psi and no greater than about 500 psi;

an adhesive applicator that applies adhesive to a portion of a folded article having folds formed by at least said first and second folding units; and

a final folding unit operatively coupled to receive a folded article having folds formed by at least said first and second folding units, said final folding unit forming an outsert by making a final fold in a folded article having folds formed by at least said first and second folding units, said final fold being made parallel to said second direction, said final fold being made so that said adhesive holds said outsert in a substantially closed position so that said outsert has no exposed unfolded exterior edges that lie in a direction parallel to said final fold, said final folding unit comprising:

a first folding roller;

a second folding roller disposed adjacent said first folding roller of said final folding unit, said first and second folding rollers of said final folding unit having a nip therebetween, said first and second folding rollers of said final folding unit causing said final fold to be made when a folded article having folds formed by at least said first and second folding units passes between said first and second folding rollers of said final folding unit; and

a movable blade member that forces a portion of a folded article having folds formed by at least said first and second folding units towards said nip between said first and second folding rollers of said final folding unit.

54. (Previously presented) An apparatus as defined in claim 53 wherein said pressing unit additionally comprises an adjustment mechanism that may be used to adjust said pressure applied by said pressing unit.

55. (Previously presented) An apparatus as defined in claim 53 wherein said pressing unit comprises a plurality of spring members disposed in a vertical stack.

56. (Previously presented) An apparatus as defined in claim 53 wherein said pressing unit comprises a plurality of cone-shaped, elastically deformable washers disposed in a vertical stack.

57. (Previously presented) An apparatus as defined in claim 53 wherein said pressing unit additionally comprises a support structure, wherein one of said pressure rollers of said pressing unit is disposed in a fixed position relative to said support structure, and wherein one of said pressure rollers of said pressing unit is disposed in a movable position relative to said support structure.

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Martin J. Hirsch
Registration No. 32,237

EVIDENCE APPENDIX

There is no evidence (other than the art applied in the claim rejections).

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Examiner	:	Paul Durand)	Date: November 8, 2005

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RELATED PROCEEDINGS APPENDIX

No decisions have been rendered in connection with any related appeals or interferences.